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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,266	08/21/2003	Patrick E. Godici	37,335	7346

7590

07/25/2006

BP America Inc.
Docket Clerk, BP Legal
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Warrenville, IL 60555

EXAMINER

POULOS, SANDRA K

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,266

Applicant(s)

GODICI ET AL.

Examiner

Sandra K. Poulos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 5/01/06. In particular, claim 1 has been amended to such that the synthetic ester is the esterification product of an aliphatic polyol reacted with a carboxylic acid, and that the yellow metal passivator is tolutriazole or benzotriazole; claim 16 has been amended so that the yellow metal passivator is tolutriazole or benzotriazole. This combination of limitations was not present in the original claims. Thus, the following action is properly made **FINAL**.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 4-6, 8-11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camenzind et al (US 5,922,657).

The discussion with respect to Camenzind in paragraph 1 of the Office action mailed 12/01/05 is incorporated herein by reference.

Camenzind discloses a lubricant composition that contains (a) a major amount of a base oil including synthetic ester oils, (b) a compound of Formula 1, and (c) metal passivators as listed in column 6, lines 30-58. It is the examiner's position that the generic chemical formula given in Formula is sufficiently limited such that one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula (MPEP § 2131.02). Moreover, it is settled in case law that the compound is therefore anticipated. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). With respect to the metal passivators, it is further examiner's position that, absent a showing of unexpected results, it would have been obvious to

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one of ordinary skill in the art to choose benzotriazole or tolutrizazole from the list of metal passivators. Lastly, while Camenzind is silent with respect to the lubricant having enhanced load carrying capacity and oxidative/corrosion stability, these properties would be inherent to the composition since the same components are present.

3. Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camenzind as applied to claims 1, 4-6, 8-11, 13 above, and further in view of Ashcraft Jr. et al (US 5,503,761).

The rejection is adequately set forth in paragraph 2 of Office action mailed 12/01/05 and is incorporated herein by reference.

Response to Arguments

4. Applicant's arguments filed 5/01/06 have been fully considered but they are not persuasive.

With respect to the argument that the formula preferably has R3 as hydrogen, case law holds that "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims." See *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960).

With respect to the argument that applicant's have shown unexpected results for a combination of DITMPA and tolutriazine or benzotriazole and lubricant, and further for use of techinal pentaerythriol, it is examiner's position that the results shown in the examples are not commensurate in scope with the claimed invention.

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Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Case law holds that whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the “objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.” In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range (i.e., scope). *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980), MPEP 716.02(d). Case law holds that evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds). *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978).

In particular, applicants have not shown support for synthetic esters based on the esterification product of an aliphatic polyol containing 4 to 15 carbon atoms and from 2 to 8 esterifiable hydroxyl groups reacted with a carboxylic acid containing 4 to 12 carbon atoms, since all of the examples employ techinal pentaerythritol. Furthermore, the examples only use tolutriazole, not benzotriazole or combinations, as currently claimed. Lastly, in the claims the synthetic ester has to be present in a major portion, which would include all values greater than 50%, however the examples only show amounts greater than about 97%. Therefore it is deemed that applicant's evidence is not commensurate in scope with the claimed invention, and thus the rejection as set forth above is maintained.

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Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra K. Poulos whose telephone number is (571) 272-6428. The examiner can normally be reached on M-F 8:00-4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Vasu Jagannathan
VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SKP

Sandra K. Poulos